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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,140	02/11/2002	Katrina Goldsmith	020144	6609
23696	7590	12/17/2003		
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			EXAMINER MOORE, JAMES K	
			ART UNIT 2686	PAPER NUMBER

DATE MAILED: 12/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,140

Applicant(s)

GOLDSMITH ET AL.

Examiner

James K Moore

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 10-15 is/are rejected.
- 7) ☒ Claim(s) 4 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed September 29, 2003, with respect to the rejection(s) of claim(s) 1-15 under 35 U.S.C. 102(e) as being anticipated by Duske, Jr. et al. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of an alternate interpretation of Duske, and in view of Wagner et al. (U.S. Patent No. 6,169,911).

Claim Objections

2. Claim 4 is objected to because of the following informalities: in line 2, "a" should be removed, and in line 3, "to" should be inserted following "respond". Appropriate correction is required.

Double Patenting

3. Applicant is advised that should claim 11 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 5 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said mobile communication terminal" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "said mobile communication terminal" in line 3.

There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "said processor" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 5, 6 and 12-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Duske, Jr. et al. (U.S. Patent No. 6,292,473).

Regarding claim 1, Duske discloses a communication terminal (AMC 18) comprising a receiver (DCE 34) for receiving a formatted message (a proforma message). The formatted message comprises a message identification code (a form identifier) and a plurality of information fields. See col. 4, lines 14-30; col. 4, line 66 through col. 5, line 16; and col. 5, lines 27-45. The communication terminal also comprises an output device (display 56) for presenting the formatted message to a user of the communication terminal, an input device (keyboard 42) for responding to the formatted message, and a memory (48) for storing the formatted message and for storing field-mapping information (part of the software code). The field-mapping information indicates information (a reply alias or a source alias) to be copied from the formatted message to a response message. See col. 5, line 63 through col. 6, line 14; col. 7, lines 3-15; col. 28, line 64 through col. 29, line 25. The communication terminal also comprises a processor for creating the response message in response to an indication from the input device of a request to respond to the formatted message. The response message comprises a response message information field (destination address alias), and information from one of the information fields of the formatted message (reply alias) is copied into the response message information field based on the field-mapping information. The communication terminal also comprises a transmitter (DCE 34) for transmitting the information relating to the response message. See col. 5, lines 27-45 and col. 28, line 64 through col. 29, line 25.

Regarding claim 5, Duske discloses all of the limitations of claim 1, and also discloses that the information from the information fields of the formatted message is

alterable by a user of the communication terminal after it is copied into the response information field. See col. 29, lines 36-54.

Regarding claim 6, Duske discloses all of the limitations of claim 1, and also discloses that the formatted message comprises two or more sub-messages (each field is a sub-message), and that the response message corresponds to a selected sub-message. See col. 4, line 66 through col. 5, line 16, and col. 28, line 64 through col. 29, line 25.

Regarding claim 12, Duske discloses a method for automatically entering information into formatted messages in a communication terminal. The method comprises selecting a formatted message (a proforma message) to respond to, determining a message identification code of the formatted message (a form identifier), identifying an information field (reply alias or source message) of the formatted message to be copied into a response message, and creating the response message. The response message comprises response message information fields, and one of the response message information fields (destination address alias) is filled in with information from one of the information fields (reply alias or source message) of the formatted message. See col. 4, line 66 through col. 5, line 16; col. 7, lines 3-15; and col. 28, line 64 through col. 29, line 25.

Regarding claim 13, Duske discloses all of the limitations of claim 12, and it is inherent that the method comprises presenting the response message to a user of the communication terminal and receiving information from the user in a response message information field (e.g., the body of the reply message) which has not been filled in.

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Regarding claim 14, Duske discloses all of the limitations of claim 13, and also discloses that the response message information field is alterable by a user. See col. 29, lines 36-54.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duske, Jr. et al. in view of Averbuch et al. (U.S. Patent No. 5,896,566).

Regarding claims 2 and 3, Duske discloses all of the limitations of claim 1, but does not disclose that the field-mapping information is configurable by a remote entity or transmitted to the communication terminal from a remote location.

Averbuch discloses a system and method for updating the software on a mobile communication terminal. Updated software is configured by a remote entity and transmitted to the mobile communication terminal from a remote location. Among the advantages of this invention is allowing the software on the mobile communication terminal to be updated without the inconvenience of bringing the mobile communication terminal to a service shop. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duske with Averbuch, such that the operating

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software of the communication terminal, which includes the field-mapping information, is configured by a remote entity and transmitted to the communication terminal from a remote location, in order to avoid the inconvenience of bring the communication terminal to a service shop to update its software.

10. Claims 7, 8, 10, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (U.S. Patent No. 6,169,911) in view of well known prior art.

Regarding claim 7, Wagner discloses a signal-bearing medium (memory 21) tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus (processing and control circuitry 20) to perform operations in a communication terminal (cellular telephone 1). See col. 2, line 59 through col. 4, line 2. The operations comprise receiving a formatted message (an electronic mail message). The formatted message comprises a message identification code (a subject line) and a plurality of information fields (name of sender, body of message). See col. 6, lines 21-36. The operations also comprise presenting the formatted message to a user of the communication terminal, receiving an indication to send a response message to the formatted message, determining a message identification code of the formatted message to which the response message corresponds, creating the response message, and transmitting the response message. See col. 6, line 37 through col. 7, line 2. Wagner does not disclose that the operations comprise identifying which of the

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information fields to be copied into the response message, or creating the response message using the identified information fields.

However, the examiner takes Official Notice that it is well known in the art of electronic mail systems to provide an electronic mail system with the function to automatically copy a message originator's address into the destination address of a reply message and to copy the body of the original message into the body of the reply message, in order to save the replying party the inconvenience of having to manually type this information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wagner, such that the operations comprise identifying which of the information fields (sender, body of message) to be copied into the response message and creating the response message using the identified information fields, in order to save the responding user the inconvenience of manually typing this information into the response message.

Regarding claim 8, Wagner in view of well known prior art teaches all of the limitations of claim 7, and Wagner also discloses that the operations of creating the response message use input from the user. See col. 6, line 64 through col. 7, line 2.

Regarding claim 10, Wagner in view of well known prior art teaches all of the limitations of claim 10, and it is inherent that the information from one of the information fields (such as the body of the message) may be alterable by a user of the communication terminal after it is copied into the response information field.

Regarding claims 11 and 15, Wagner in view of well known prior art teaches all of the limitations of claim 7, and Wagner also discloses that the formatted message

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comprises two or more sub-messages (each field of the message is a sub-message), and that the response message corresponds to a selected sub-message. See col. 6, lines 22-36.

Allowable Subject Matter

11. Claims 4 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

The present invention is directed to a communication terminal comprising a receiver for receiving a formatted message, an input device for responding to the formatted message, and a memory for storing field-mapping information. The field-mapping information indicates information to be copied from the formatted message to a response message. The communication terminal also comprises a processor for creating the response message in response to an indication from the input device of a request to respond to the formatted message. The processor determines a message identification code corresponding to the selected formatted message.

Claim 4 identifies the uniquely distinct features "said field-mapping information comprises a stored message identification code" and "said processor... matches said determined message identification code to said stored message identification, and

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inserts information from said selected formatted message into said response message as specified by said field identification information corresponding to said stored message identification code."

The closest prior art, Duske, Jr. et al., discloses a communication terminal comprising a receiver for receiving a formatted message, an input device for responding to the formatted message, and a memory for storing field-mapping information. The field-mapping information indicates information to be copied from the formatted message to a response message. The communication terminal also comprises a processor for creating the response message in response to an indication from the input device of a request to respond to the formatted message. The processor determines a message identification code corresponding to the selected formatted message. However, Duske, Jr. et al. fails to anticipate or render the above underlined limitations obvious.

The present invention is also directed to a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform operations for automatically entering information into formatted messages in a communication terminal. The operations comprise receiving a formatted message. The formatted message comprises a message identification code and a plurality of information fields. The operations also comprise receiving an indication to send a response message to the formatted message, and identifying which information fields, from the plurality of information fields, to be copied into the response message.

Claim 9 identifies the uniquely distinct features "wherein the operations of identifying which information fields to be copied into said response message comprises operations of: matching said message identification code corresponding to said formatted message to a stored message identification code" and "copying information contained within at least one of said plurality of information fields of said formatted message into said response message as identified by field-mapping information corresponding to said stored message identification code."

The closest prior art, Wagner et al., discloses a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform operations in a communication terminal. The operations comprise receiving a formatted message. The formatted message comprises a message identification code and a plurality of information fields. The operations also comprise receiving an indication to send a response message to the formatted message. However, Wagner fails to anticipate or render the above underlined limitations obvious.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

12/11/03

JKM

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
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